

REMARKS**Status of the Claims**

Upon entry of the amendment above, claims 19-71 will be pending, claims 19, 36, and 57 being independent.

Summary of the Office Action

Applicants' substitute specification, filed on February 20, 2003, is denied entry, as explained by the Examiner in Section 1, at the top of page 2 of the Office action, on the ground that a "new matter" issue has been raised.

Claims 24, 27, 28, and 29 are rejected under 35 USC §112, first paragraph, on the ground that the expression "fixing device" in these claims represents "new matter," the subject matter of which the inventors allegedly did not have possession at the time the application was filed. See Section 3, beginning near the bottom of page 3 of the Office action.

Newly presented claims 57-64 are rejected under 35 USC §112, second paragraph, as being indefinite, as explained in Section 5 on page 3 of the Office action.

Claims 19-24, 28, 29, 32, 34, 36, 38-41, 46, 47, and 49 are rejected under 35 USC §102(b) as being anticipated by COCHRANE (U.S. Patent No. 5,269,078). See Section 7, beginning on page 4 of the Office action.

Claims 19, 20, 31, 36, 49, 50, and 57-64 are rejected under 35 USC §102(b) as being anticipated by SALOMON (U.S. Patent No. 4,160,332). See Section 8, on page 6 of the Office action.

Claims 19, 20, 23, and 24 continue to be rejected under 35 USC §102(b) as being anticipated by YOUNG (U.S. Patent No. 1,650,000). See Section 9, on page 6 of the Office action.

Claims 26, 27, 41-45, 48, 49, and 55 are rejected under 35 USC 103(a) as being unpatentable over COCHRANE, SALOMON, or YOUNG (i.e., "over the references as applied

to claims 24 and 36 above") in view of French Patent Publication No. 2 615 074). See Section 11, beginning on page 8 of the Office action.

Claims 25, 30, and 37 are rejected under 35 USC 103(a) as being unpatentable over COCHRANE or YOUNG (i.e., "over the references as applied to claims 19, 24 and 36 above") in view of BERGERON (U.S. Patent No. 5,832,632). See Section 12, beginning near the middle of page 9 of this final Office action.

Claims 33, 35, and 51-54 are rejected under 35 USC §103(a) as being unpatentable over COCHRANE alone. See Section 13, on page 10 of the Office action.

Claim 56 is not rejected.

Response to the Office Action

A. Summary of Interview With Examiner Stashick

Initially, Applicants' undersigned representative extends his gratitude to Examiner Stashick for are grateful for the Examiner's time given to the purpose of an interview on July 22, 2003.

First, the denial of entry of Applicants' substitute specification and the issue of "new matter" (i.e., the rejection under 35 USC §112, first paragraph) was discussed. The substitute specification had been denied entry based upon Applicants' amendment whereby certain occurrences of "fixing means" had been changed to "fixing device" and claims 24, 27, 28, and 29 were amended to use the expression "fixing device".

The Examiner explained at the interview that he did not intend to require that the so-called "means" terminology be maintained. Instead, the Examiner explained his position is that it would be improper to characterize a Velcro-type fastener as a "device". He mentioned, in this regard, that a "device" must include more parts than are part of a Velcro-type fastener.

Although no specific alternative was agreed to at the interview, Applicants' representative agreed to make an amendment to address the Examiner's concern.

Also discussed during the interview was the wording of claims 57-64 which gave rise to the Examiner's rejection under 35 USC §112, second paragraph.

Specifically, as shown in the amendment above to claim 57, Applicants have agreed (at the Examiner's suggestion) to change "a plane extending ... through a heel of the foot of a wearer" to "a plane extending ... through an area adapted to receive a heel of the foot of a wearer", so as to avoid any possibility that one might construe Applicants' claims as an attempt to "claim a part of the human body".

The three primary references relied upon in the rejections under 35 USC §102(b) were also discussed during the interview.

In this regard, Applicants' representative explained his position that, among other things, neither COCHRANE nor YOUNG discloses a strap that extends through the area of the heel of the foot of the wearer of the boot.

In reply, the Examiner explained that the rejected claims do not adequately describe the direction in which the band extends. He pointed out that if one were to consider the width-wise dimension of the straps of COCHRANE or YOUNG, *e.g.*, that he could show that the straps extend, in the direction that the straps extend width-wise, through the area of the heel.

Applicants' representative agreed, in reply, to amend the claims to refer to the band as extending along its *length* in the claimed direction through the area of the heel.

Applicants representative also agreed, at the request of the Examiner, to specify that the aforementioned direction extends from the flexion fold *to* rather than *toward* the area of the heel.

The patent to SALOMON was also discussed during the interview. Applicants note that independent claim 57 is rejected solely on the basis of SALOMON.

The relative rigidity of the upper of the alpine ski boot of SALOMON was discussed. In column 4, line 7, SALOMON refers to the shell 17 as being "made of rigid materials." At

the interview, it was pointed out that Applicants' claims 19 and 38 refer to the upper as "flexible or semi-rigid."

Although an agreement regarding the difference in flexibilities between Applicants' disclosed invention and that of SALOMON was not reached at the interview, Applicants' representative agreed to present an amended claim which is directed to a related feature of the invention described, *e.g.*, in paragraphs 0020 and 0022, and schematically shown in Fig. 3, whereby the tightening mechanism of the invention serves to *deform* the upper at the sides, so as to facilitate lateral support of the wearer's foot.

By contrast, in addition to the shell 17 of SALOMON's boot being made of rigid materials, the straps 8, 8' of SALOMON are not disclosed as effecting any deformation of the shell. In fact, on one side of the boot, the straps are connected to a cable that extends *through* the shell of the boot and, therefore, would not appear to apply a force to the shell. Further, even on the side of either strap 8, 8' attached to the shell, there is no disclosure of any deformation.

Further, regarding independent claims 19 and 36, Applicants note that the strap is specified as being fixed at *both* lateral and medial sides of the inner surface of the upper.

B. Withdrawal of Rejection of Claims 24, 27, 28, and 29 Under 35 USC §112, First Paragraph

Applicants request reconsideration and withdrawal of the rejection of claims 24, 27, 28, and 29 under 35 USC §112, first paragraph, as well as entry of the substitute specification attached hereto.

Applicants do not agree that the ordinary and customary meaning of the term "device" would preclude an interpretation of Applicants' disclosure of the Velcro-type fasteners, identified in the drawings by reference numerals 7, 27, and 29, for example, even on the ground that a fixing "device" encompasses additional structure that a "means" might not. Indeed, Applicants

question whether the term "means" cannot encompass structure such as "links, plates, etc.", as asserted in the Office action.

In this regard, the first two definitions of the term "device" in *The American Heritage Dictionary of the English Language*, Fourth Ed., Houghton Mifflin Co., Boston, Mass., 2000, are the following: "1. A contrivance or an invention serving a particular purpose, especially a machine used to perform one or more relatively simple tasks. 2a. A technique or means."

Thus, the second definition above describes a "device" as a "means" in the ordinary sense of the term "means". Further, with respect to the specification (not the claims, specifically), the expression used is only with regard to that which is being described and shown in the drawings. In this sense, Applicants submit that a Velcro-type fastener can be regarded as either a means or a device.

The foregoing notwithstanding, however, and for the purpose of advancing prosecution of the instant application, in the amendment being presented herein, Applicants have changed "fixing device" to "fastening arrangement". Applicants respectfully submit that the Velcro-type fasteners disclosed in the non-limiting embodiments are encompassed by the expression "fastening arrangement" and that, in Applicants' description, the expression is appropriate. Furthermore, in the rejected claims (*i.e.*, claims 24, 27, 28, and 29), Applicants have used the expression "fastening arrangement" or "gripping arrangement." Thereby, Applicants are merely expressing their intent not to invoke the claim construction protocol set forth in 35 USC §112, sixth paragraph.

If the Examiner were to prefer yet a different formulation, Applicants invite him to make such a suggestion and, to the extent that the meaning and scope of Applicants' invention were not to be altered, Applicants grant the Examiner authority to make an Examiner's Amendment to the affected portions of Applicants' disclosure that would more closely correspond to the Examiner's preference.

In view of the amendment and Applicants' foregoing comments, reconsideration and

withdrawal of the objection to the specification and entry of the amendment to claims 24, 27, 28, 29, as well as entry of the substitute specification submitted herewith are kindly requested.

C. Withdrawal of Rejection of Claims 57-64 Under 35 USC §112, Second Paragraph

Applicants request reconsideration and withdrawal of the rejection of claims 57-64 under 35 USC §112, second paragraph.

In response to the rejection, and consistent with the discussion had at the interview, mentioned above, claim 57 has been amended to change "a plane extending ... through a heel of the foot of a wearer" to "a plane extending ... through an area adapted to receive a heel of the foot of a wearer", so as to avoid any possibility that one might construe Applicants' claims as an attempt to "claim a part of the human body".

Further, Applicants note that the rejection includes the statement that "Figure 2 shows a plane passing through the fastening area and flexion fold area but does not show it passing through a user's heel."

Applicants respectfully disagree.

In paragraph [0019] of the specification, Applicants describe the line L of Fig. 3 as "being the line connecting the flexion fold 102 to the heel 101 of the foot."

In view of the amendment and Applicants' remarks, reconsideration and withdrawal of the rejection is kindly requested.

D. Withdrawal of Rejections Based Solely or Primarily Upon COCHRANE

Applicants request reconsideration and withdrawal of the rejections that are based solely or primarily upon COCHRANE.

As mentioned above in connection with the interview with the Examiner on July 22, 2003, Applicants have amended independent claims 19 and 36 to refer to the retention band of the invention as extending along a *length* thereof from the flexion fold area to an area adapted to receive the heel of the foot.

Because, as mentioned by the Examiner during the interview, the rejections based upon COCHRANE are based, at least in part, upon an interpretation that is *not* limited to the length-wise extent of the retention band as defining the direction specified in Applicants' claims, reconsideration and withdrawal of the rejection of the claims, as now amended.

Applicants also request that the rejections based upon COCHRANE be withdrawn for other reasons of record.

E. Withdrawal of Rejections Based Solely or Primarily Upon YOUNG

Applicants request reconsideration and withdrawal of the rejections that are based solely or primarily upon YOUNG.

Again, as mentioned above in connection with the interview with the Examiner on July 22, 2003, Applicants have amended independent claims 19 and 36 to refer to the retention band of the invention as extending along a *length* thereof from the flexion fold area to an area adapted to receive the heel of the foot.

Because, as mentioned by the Examiner during the interview, the rejections based upon YOUNG are based, at least in part, upon an interpretation that is *not* limited to the length-wise extent of the retention band as defining the direction specified in Applicants' claims, reconsideration and withdrawal of the rejection of the claims, as now amended.

Applicants also request that the rejections based upon YOUNG be withdrawn for other reasons of record.

F. Withdrawal of Rejections Based Solely or Primarily Upon SALOMON

Applicants request reconsideration and withdrawal of the rejections that are based solely or primarily upon SALOMON.

Independent claim 57 has been amended, as alluded to above, to specify that the upper has a flexibility whereby, upon tightening of the foot within the upper, the two sides of the upper are *inwardly deformed*.

As mentioned, this feature of the invention is described in paragraphs 0020 and 0022 of

the specification and shown in Fig. 3. The deformation of the sides of the upper, by means of the tightening mechanism, facilitates lateral support of the wearer's foot.

The boot of SALOMON provides no such deformation.

Further, in independent claims 19 and 36, Applicants call for the strap to be fixed at *both* lateral and medial sides of the inner surface of the upper. In SALOMON, by contrast, the straps 8, 8' are connected to cables that extend through the upper.

Reconsideration and withdrawal of the rejection based upon SALOMON, solely or primarily, is requested for the reasons given above as well as for reasons of record.

G. Summary of New Claims

As mentioned above, new claims 65-71 are presented. All are dependent.

Claims 65 and 68 (depending from claims 19 and 36, respectively) call for at least a part of the retention band to extend *over*, in addition to "at least partially surround" the foot of the wearer. Although parent claims 19 and 36 are believed to distinguish the invention over YOUNG for other reasons, claims 65 and 68 additionally differentiate the invention from YOUNG, whereby the straps are positioned *below* the foot.

Claims 66 and 69 (depending from claims 19 and 36, respectively) call for the upper to be "sufficiently flexible so that, upon tightening of the foot within the upper, said two sides of said upper are inwardly deformed." This relates to the limitation added to independent claim 57, mentioned above.

Claims 67, 70, and 71 (depending from claims 19, 36, and 57, respectively) call for the retention band to extend to a fastening arrangement to be removably affixed to an area of the upper that is *forward* of an area of the upper that is adapted to receive a lower leg of the wearer. By contrast, in SALOMON, manipulations of the tightening mechanism are made rearward of the lower leg.

SUMMARY AND CONCLUSION

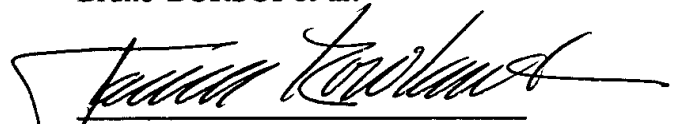
The grounds of objection and rejection advanced in the Office action have been addressed and are believed to be overcome. Reconsideration and allowance are respectfully requested in view of the amendment and remarks above.

A check is enclosed for payment of a claim fee. No additional fee is believed to be due at this time. However, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and complete to Deposit Account No. 19-0089.

Further, although no extension of time is believed to be necessary at this time, if it were to be found that an extension of time were necessary to render this reply timely and/or complete, Applicants request an extension of time under 37 CFR §1.136(a) in the necessary increment(s) of month(s) to render this reply timely and/or complete and the Commissioner is authorized to charge any necessary extension of time fee under 37 CFR §1.17 to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,
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